

REMARKS

Claims 1, 2 and 4-13 are pending in this application. Claims 1 and 4-13 are amended herein. Claim 3 has been cancelled, without prejudice. Claim 2 remains unchanged. No new matter has been introduced.

Claims 1, 8, 9 and 11-13 are rejected under 35 USC §112, 1st paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the Applicant, at the time the application was filed, had possession of the claimed invention, i.e. new matter. The Examiner makes a similar objection under 35 USC §132 to an amendment filed June 26, 2001, where the Applicant sought to introduce, into the summary portion of the application, the language of the original claims, by substituting, at page 2, lines 27-29, the language of these original claims directly for mention of the claims by number. The specification is also subject to an objection for failure to provide proper antecedent basis for the claimed subject matter. We respectfully traverse.

The Examiner's position is based on the mistaken presumptions that the original claims of the application are not part of the written disclosure upon which the Applicant may rely, and that amended claims may be directed only to subject matter that appears within the detailed description portion of the application, e.g., and not to subject matter found elsewhere in the written description, e.g., in the summary, claims, drawings, etc. These presumptions are simply not correct. Rather, it is well settled that the "written description" of an invention encompasses all of the information presented in the application as originally filed. This consists of the entire specification, including, without limitation, the title, abstract, field of invention, background, summary, brief description of drawings, detailed description of the invention and mode of operation, claims, abstract, and drawings. The Examiner is referred specifically in this regard to MPEP §608.1 and §2163(I), which says, in relevant part:

It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. [emphasis provided]

As a result, mere movement of information within the specification, e.g., from the claims to the summary, to the detailed description or to the drawings, does not, and cannot, constitute introduction of new matter. In particular, in the present application, all of the features recited in the amendment filed June 26, 2001, as well as all of the features of amended claims 1, 8, 9 and 11-13, were recited in the claims of the application as originally filed. Therefore, amendment of the application to recite those same features in other sections does not constitute introduction of new matter. Furthermore, since the "specification" by definition includes the claims (see MPEP §608.1), and the requirement for "written description" does not require description in two places, there is also no requirement that features recited in the claims find antecedent basis elsewhere in the specification. On the basis of the above, we request that the objections under 37 CFR §1.75(d)(1), MPEP §608.01, 35 USC §132 and 35 USC §112, 2nd paragraph be withdrawn.

Claims 1, 9, 11, and 13 are rejected under 35 USC §112, 1st paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-13 are also rejected under 35 USC §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Again, we respectfully traverse.

The Applicant does not agree that the elements noted by the Examiner are in any way unclear or indefinite to one skilled in the art; however, the claims are amended herein to substitute equivalent, common American terminology for the terms questioned by the Examiner. These equivalent substitutions include: --fabric-- for "material" (claims 7 and 11); --hook-and-loop type fasteners-- for "touch-and-close" fasteners (claim 9); --zipper-- for "zip fastener" (claim 9); --snap-- for "press-stud" (claim 9); --reins-- for "grips" (claim 10); --belt-- for "strap (or leather strap) with an overhang and eyelet" (claim 10); and --printed cloth-- for "a pattern imprinted on material" (claim 13). The claims are also amended to correct instances where proper antecedent basis was found lacking. No new matter has been introduced.

The Examiner has also made objection to the drawings under 37 CFR 1.83(a) for failure to show elements of structure recited in the claims. In response, submitted herewith for approval

by the Examiner, and under separate cover addressed to the Official Draftsman, is one (1) sheet of amended drawings with our proposed changes marked in red. In particular, FIG. 1 is amended to indicate a leather layer forming a saddle in the seat region, as recited in claim 8, and described further in the specification as originally filed at page 5, lines 17-18 and page 7, lines 17-18; FIG. 2 is amended to indicate that the basic body is formed of a core with surrounding synthetic flexible foam material, as recited in claims 4 and 5, and described further in the specification as originally filed at page 4, lines 1-8 and page 8, lines 10-13; and FIG. 2 is also amended to indicate that the non-slip backing upon the rocking surface of the basic body is attached removably, e.g. to permit exchange or for cleaning or washing, by fasteners such as touch-and-close (i.e. hook-and-loop) fasteners (e.g. as sold under the trademark VELCRO®), zipper, buttons or snaps, or belt or strap with overhang and eyelet, as recited in claim 9, and described further in the specification as originally filed at page 7, lines 21-26. Conforming amendments are also made to the specification. No new matter has been introduced.

We turn now to the Claim Rejections over the prior art, wherein: Claims 1, 2 and 9-11 are rejected under 35 USC §103(a) as being obvious and therefore unpatentable over Papst U.S. 3,053,534 in view of Taylor U.S. 4,716,664; Claims 3, 6 and 7 are rejected under 35 USC §103(a) as being obvious and therefore unpatentable over Papst '534 in view of Taylor '664, and further in view of GB 1,326,711; Claim 12 is rejected under 35 USC §103(a) as being obvious and therefore unpatentable over Papst '534 in view of Taylor '664, and further in view of Curry, Sr. U.S. 5,000,712; and Claims 8 and 13 are rejected under 35 USC §103(a) as being obvious and therefore unpatentable over Papst '534 in view of Taylor '664, and further in view of Official Notice. We respectfully traverse.

Applicant's invention of the broadest claim (claim 1, as amended) is a children's rocking toy in the form of a stylized horse. The rocking toy has a one-piece basic body made of flexible synthetic foam material with a base formed of a simply curved rocking surface. The body widens in cross section in a continuous and uniform contour from its upper narrow side toward the curved rocking surface at the base. The rocking surface has a non-slip backing of leather or imitation leather. None of the prior art references cited by the Examiner, whether taken alone, or

in any proper combination, teaches or suggests Applicant's invention, as now more clearly claimed.

The Examiner proposes to combine Papst '534, describing a rocking horse, with Taylor '664, describing a bowling shoe. We respectfully traverse.

In particular, Papst '534 describes a rocking horse formed of a hollow shell of plastic or plastic composition. As noted by the Examiner, the material is characterized (at col. 1, lines 21-22) as being "sufficiently yieldable or flexible," without further definition, but as may be seen from the drawings, the material has structural strength and rigidity sufficient to bear the weight of a rider, even in the form of a light-weight, hollow shell with openings of considerable height and breadth in the opposite side walls. Furthermore, the rocking horse of Papst '534 is completely open at the bottom and rests only upon narrow runners. As a result, there is no "base surface" of any kind similar to that described by Applicant, nor any teaching or suggestion for a non-slip backing thereupon.

The Examiner proposes to combine the teachings of Papst '534 with teaching in Taylor '664 for a bowling shoe having a roughened leather sole. References may be properly combined only if there is some suggestion in the prior art for making the combination.¹ There is no suggestion in Papst '534 or Taylor '664 for the combination proposed by the Examiner of a rocking horse and a bowling shoe. Papst '534, in fact, has no base surface as described and claimed by Applicant, and therefore no suggestion for a covering thereupon, and, as a result, the teaching of Taylor '664 of a bowling shoe is entirely non-analogous to the rocking horse of Papst '534.

The Examiner also proposes to combine Papst '534 and Taylor '664 with GB '711, which describes a rocking toy in the form of a synthetic foam block. We respectfully traverse.

Again, references may be properly combined only where suggestion for the combination is found in the references, and the proposed modification cannot render the prior art unsatisfactory for its intended purpose. (see MPEP §2143.01) Here, a stated key object of the invention in Papst '534, described at col. 1, lines 24-31, is as follows:

Yet a further object of the present invention resides in the provision of means contributing to a modernized and light-weight rocking horse structure, which may

¹ *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986).

be fabricated by mass production methods and which is substantially a hollow coniform [sic: cuneiform] or tapering shell of plastic or plastic composition, which shell includes a seating facility, a stand or support therefor with openings or cutout portions... *[emphasis provided]*

In contrast, according to the invention of GB '711, at p. 1, lines 13-15:

According to the invention, there is formed a rocking toy [with] a body formed entirely of resilient foam material... *[emphasis provided]*

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.² Clearly, the body construction and materials of Papst '534 and the body construction and materials of GB '711 are mutually exclusive, and there is entirely no teaching or suggestion of the desirability for modifying the references at all, and certainly no suggestion for combining the references in a manner to achieve Applicant's invention.

The Examiner also proposes to combine Papst '534 and Taylor '664 with Curry, Sr. '712, which, at col. 7, line 44, describes a rocking toy have a mane formed of fibrous strands of material. However, Curry, Sr. '712 fails to provide teaching or suggestion of other features of Applicant's invention found lacking above with respect to Papst '534 and Taylor '664.

Finally, the Examiner proposes to combine Papst '534 and Taylor '664 with "Official Notice" of a seat region formed of leather. As above, the "Official Notice" provides no teaching or suggestion of other features of Applicant's invention found lacking with respect to Papst '534 and Taylor '664. Furthermore, "Official Notice" merely signals that no prior art reference teaching the mentioned feature of Applicant's invention was found, which is more an indication of novelty than of obviousness.

On the basis of the above, we submit that all of the claims are distinguishable over the prior art, and thus in condition to be allowed.

Attached is a marked-up version of the changes being made by the current amendment.

Applicant submits that this application is now in condition for allowance. Early favorable action is solicited in this regard. Enclosed is a Petition for Automatic Extension with a check for

² *In re Lalu*, 747 F.2d 703, 233 USPQ 1257 (Fed. Cir. 1984).

Applicant : Jost-Ulrich Kügler
Serial No. : 09/869,272
Filed : June 26, 2001
Page : 10

Attorney's Docket No.: 13287-002001 / K27520PCUS
DO/bp

\$55.00 in payment of the required fee. Please apply any other charges or credits to Deposit
Account No. 06-1050.

Respectfully submitted,

Date: December 20, 2002



Timothy A. French
Reg. No. 30,175

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Version with markings to show changes made

In the specification:

Paragraph beginning at page 2, line 26 has been further amended as follows:

--According to the invention, the object is achieved by a children's rocking toy, in particular in the form of a stylized horse, having a one-piece basic body made of flexible synthetic foam material, a simply curved rocking surface forming the base of the rocking toy and a seat region molded into it. Expedient further refinements of the rocking toy include one of more the following. The basic body widens in its cross section towards the base. The seat region is molded into the basic body to an extent sufficient to provide a backrest region. The basic body has, at its two longitudinal end regions, two curvatures in the form of a horse's head and a horse's rear part, respectively, with the vertical height of both curvatures being greater than the vertical height of the seat region, so that they form an additional support for a child sitting in the seat region. The material forming the basic body is of a Shore hardness sufficient for the basic body, on the one hand, to have sufficient stability when rocking and, on the other hand, can be deformed in a sufficiently flexible manner so that it yields when a child is resting on one of its side surfaces. [The flexible synthetic material is a foam.] The basic body is manufactured, in particular cut, from a foam block. The rocking surface has a non-slip backing made of leather or imitation leather. The basic body is covered with a material covering. The seat region has a leather layer as the saddle. The backing is connected to the basic body by releasable fastenings, F (indicated in dashed line in FIG. 2), e.g., by a touch-and-close or zip fastener or is buttoned to it (press-stud) or by a strap (or leather strap) with an overhang and eyelet, for exchanging or for cleaning or washing purposes. The horse's head has a mane and ears designed as grips, and the horse's rear part has a tail. The horse's rear part has a tail made from the material covering. The tail and the mane of the horse's head consist of real, artificial or stylized hairs. The mane of the horse's head is designed as a pattern imprinted into the material covering. The basic body, which consists of a foam, has, for stabilization purposes, a core that consists of foams of expandable polystyrene.--

Paragraph beginning at page 4, line 1 has been further amended as follows:

--In an advantageous refinement of the invention the basic body has a core, C (indicated in dashed line in FIG. 2). The material of this core is harder than the material of the basic body which surrounds the core. The core material is preferably particle foams made of expandable polystyrene (for example styropor). The core brings about an additional increase in the stability without substantially increasing the weight of the rocking toy.--

Paragraph beginning at page 5, line 8 has been further amended as follows:

--A non-slip backing 2a is provided on the rocking surface. The tail 6 and mane 7 of the horse are manufactured from artificial hairs. In a further embodiment (not shown), the tail 6 and mane 7 are manufactured from stylized hairs (for example, from cord). The horse's head 4 also has two laterally fitted eyes, either as depressions in the basic body (as shown in FIGS. 1 and 2) or in the form of two eyes sewn on at the sides or set in (not shown). A bridle 12 is placed around the horse's head 4. If appropriate, the seat region 3 can be covered by a saddle, S (indicated in dashed line in FIG. 1) [(not shown)]. The horse's head is also provided with ears 11 which are used as grips.--

In the claims:

Claims 1 and 4-13 have been amended, as follows:

--1. (Twice Amended) Children's rocking toy in the form of a stylized horse, having a one-piece basic body made of flexible synthetic foam material which has a simply curved rocking surface forming [the] a base of the rocking toy and a seat region molded into it, the basic body forming in its tipped over side position a reclining or sleeping base for a child, characterized in that the seat region is molded a good distance into the basic body and thereby forms a backrest region, in that the basic body has, at its two longitudinal end regions, two curvatures in the form of a horse's head and of a horse's rear part, respectively, with [the height of both curvatures] each curvature having a height relatively [being] greater than [the depth of] the molded-in seat region, as a result of which an additional support for a child sitting in the seat region is formed, in that [the] a cross section of the basic body widens from its upper, narrow side, which forms the horse's head, seat region and horse's rear part, towards the curved rocking

surface in a continuous and uniform contour of [the] its side surfaces, and in that the rocking surface has a non-slip backing made of leather or imitation leather.--

--4. (Twice Amended) Children's rocking toy according to Claim 1 or 2, characterized in that the basic body has a core whose material is harder than the flexible synthetic foam material surrounding it.--

--5. (Twice Amended) Children's rocking toy according to Claim 4, characterized in that the basic body has a core whose material is harder than the flexible synthetic foam material surrounding it, the core of the basic body consisting of foams made of expanded polystyrene.--

--6. (Twice Amended) Children's rocking toy according to Claim 1 [3], characterized in that the basic body is manufactured, in particular cut, from a foam block.--

--7. (Twice Amended) Children's rocking toy according to Claim 1, characterized in that the basic body [is covered with a material] has a fabric covering.--

--8. (Twice Amended) Children's rocking toy according to Claim 1, characterized in that the seat region has a leather layer [as the] forming a saddle.--

--9. (Twice Amended) Children's rocking toy according to Claim 1, characterized in that the non-slip backing is connected to the basic body by a [touch-and-close] hook-and-loop-type fastener or [zip] by a zipper fastener or [is buttoned to it] by buttons or snaps or by a belt or strap with an overhang and eyelet, for exchanging or for cleaning or washing purposes.--

--10. (Twice Amended) Children's rocking toy according to Claim 1, characterized in that the horse's head has a mane and ears designed as grips for a rider, and the horse's rear part has a tail.--

--11. (Twice Amended) Children's rocking toy according to Claim 7 [1], characterized in that the horse's rear part has a tail made from the [material] fabric covering.--

--12. (Twice Amended) Children's rocking toy according to Claim 10, characterized in that [the tail and the mane of] the horse's head has a mane, and the mane and tail consist of real, artificial or stylized hairs.--

--13. (Twice Amended) Children's rocking toy according to Claim 7 [8], characterized in that [the mane of] the horse's head has a mane formed [is designed] as a pattern printed on [imprinted into the material] the fabric covering.--